

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

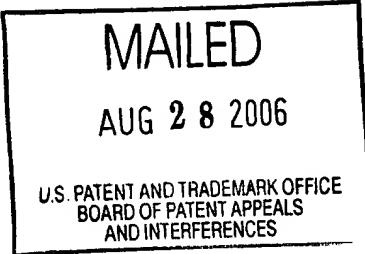
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* RAMESH LHILA

Appeal No. 2006-0994  
Application No. 09/898,969

ON BRIEF



Before GARRIS, WALTZ, and FRANKLIN, *Administrative Patent Judges*.  
WALTZ, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on an appeal from the primary examiner's refusal to allow claims 1 through 20, which are the only claims pending in this application, as amended subsequent to the final rejection (see the amendment dated Sep. 30, 2004, as entered by the examiner as per the Advisory Action dated Oct. 15, 2004; see the Brief, page 2, ¶IV).<sup>1</sup> We have jurisdiction pursuant to 35 U.S.C. § 134.

<sup>1</sup> We refer to and cite from the revised Brief dated June 20, 2005.

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According to appellant, the invention is directed to an acrylic pressure-sensitive adhesive (PSA) tape comprising a layer of an acrylic backing, at least one layer of a PSA disposed on at least one side of the backing, and a primer layer disposed between the layer of the backing and the layer of the PSA (Brief, page 2, ¶V). A copy of representative independent claim 1 can be found in the Claims Appendix to appellant's Brief.

The examiner has relied on the following references as evidence of obviousness:

De Santis	3,707,521	Dec. 26, 1972
Mazurek et al. (Mazurek)	5,264,278	Nov. 23, 1993
Ko et al. (Ko)	5,308,887	May 03, 1994
Ragland et al. (Ragland)	5,503,927	Apr. 02, 1996
Everaerts et al. (Everaerts)	5,612,136	Mar. 18, 1997

Claims 1-8, 11-14, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Everaerts in view of Ragland and De Santis (Answer, page 3). Claims 9, 10, 15 and 16 stand rejected under § 103(a) as unpatentable over the references applied against claim 1 further in view of Ko (Answer, page 6). Claims 17 and 20 stand rejected under § 103(a) as unpatentable over the references applied against claim 1 further in view of Mazurek (*id.*). Finally, claim 19 stands rejected under § 103(a)

as unpatentable over the references applied against claim 1 further in view of Ko and Mazurek (Answer, page 7).

Based on the totality of the record, including the arguments in the Brief, we affirm all rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

#### OPINION

##### A. *The Rejection over Everaerts, Ragland and De Santis*

The examiner finds that Everaerts discloses an adhesive tape comprising a core layer and a PSA layer coated on at least one side of the core layer, where the core layer of the reference corresponds to the backing layer of the claimed invention (Answer, page 3).<sup>2</sup> The examiner finds that Everaerts discloses that the core layer comprises about 80 parts or more of an acryl alkylate monomer and up to about 20 parts of a copolymerizable modifier monomer, while teaching that the alkyl acrylate monomers can be formed from a mixture of two independent monomers, as can the modifier monomers (Answer, pages 3-4). The examiner further finds that the primary reference discloses the presence of a

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<sup>2</sup>Since appellant does not argue the separate patentability of any specific claim, we limit our consideration in this rejection to independent claim 1. See 37 CFR § 41.37(c)(vii) (2004).

filler, a crosslinker, and a primer layer, although the specific composition of the primer layer is not disclosed (Answer, page 4). Therefore the examiner applies Ragland for its teaching of a PSA laminate comprising a silicone foam, an acrylic PSA layer, and a urethane primer layer disposed between the foam and the adhesive "to provide the laminate having long-term bond strength" (*id.*). The examiner finds that Ragland refers to De Santis for the disclosure of the specific composition of the primer layer, and De Santis teaches that the primer layer is made from a silane modified elastomer solution (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in this art at the time of appellant's invention to employ the primer layer taught by Ragland and De Santis as the primer layer of Everaerts motivated by the desire to provide the adhesive tape with long-term bond strength (Answer, page 5). We agree.

Appellant argues that the examiner has not identified any teaching, suggestion or motivation to combine Everaerts with Ragland and De Santis to arrive at the claimed invention (Brief, page 5).<sup>3</sup> Appellant argues that Everaerts discloses the use of

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<sup>3</sup> We note that appellant does not contest or dispute any of the specific factual findings made by the examiner.

an adhesive to mount a device to a surface while Ragland, on the other hand, is directed to the problem of inadequate bond strength that results from conventional lamination of a layer of PSA to a silicone foam sheet (*id.*). Appellants further argue that the use of an adhesive to mount a device to a surface is not indicative of the structural integrity of a tape, and one of ordinary skill in the art would not look to combine an adhesive for adhering objects to surfaces with devices having adhesives directed to improving bond strength within the device (Brief, page 6).

These arguments are not persuasive. As correctly set forth by the examiner (Answer, pages 8-9), Everaerts discloses that there is often interfacial failure between the primer coating layer and the foam backing (col. 10, ll. 15-34, and col. 23, ll. 1-32, including Table 9). Accordingly, we determine that one of ordinary skill in this art would have been led to the teachings of Ragland, where this reference teaches the advantages of a curable urethane primer layer to yield superior short-term and long-term bond strength between the primer layer and the foam backing in a PSA laminate (Ragland, abstract; col. 3, ll.

50-52).<sup>4</sup> See *In re Huang*, 100 F.3d 135, 139 n.5, 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996) (A suggestion to combine may also come from the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem). Furthermore, Ragland specifically refers to De Santis for the specific composition of the primer layer (Ragland, col. 6, l. 49-col. 7, l. 1). We note that De Santis teaches that his specific primer layer produces advantageous results of improving the bonding to metals, which is a similar environment to the Everaerts adhesive (De Santis, col. 4, l. 75-col. 5, l. 2).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of obviousness based on the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's

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<sup>4</sup> We note that Ragland additionally teaches the use of silicone rubbers as a conventional primer (col. 9, ll. 64-65). There has been no determination by the examiner or the appellant as to whether this conventional primer is the same or similar to the claimed primer "silane modified rubber solutions." We also note the specification fails to further define or provide guidelines for this term (see ¶[0056]).

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rejection of claims 1-8, 11-14 and 18 under § 103(a) over Everaerts in view of Ragland and De Santis.

*B. The Remaining Rejections*

The remaining rejections on appeal are all based on Everaerts, Ragland and De Santis as discussed above and in the Answer, further adding the tertiary references to Ko and/or Mazurek (Answer, pages 6-7). Appellant does not present any additional arguments concerning these remaining rejections on appeal (Brief, pages 6-8). Accordingly, we adopt our remarks from above, as well as the findings and conclusions of law found in the Answer, and also affirm these rejections.

*C. Summary*

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

**AFFIRMED**

*Bradley R. Garris*  
BRADLEY R. GARRIS )  
Administrative Patent Judge )  
 )  
*Thomas A. Waltz*  
THOMAS A. WALTZ ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
 ) INTERFERENCES  
*Beverly A. Franklin*  
BEVERLY A. FRANKLIN )  
Administrative Patent Judge )

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